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MAY 27 2004
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. 10/027,632 Art Unit: 1631
Applicant: Wang, David G. Examiner: Shubo Zhou
Date Filed: December 21, 2001 Conf. No. 1497
Docket No. 108827-129 Cust. No. 23483
Title: IDENTIFICATION AND MAPPING OF SINGLE NUCLEOTIDE
POLYMORPHISMS IN THE HUMAN GENOME

CERTIFICATION UNDER 37 CFR § 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date set forth below.

May 25, 2004

Date of Signature and of Mail Deposit

Rochelle Harper Greenidge
Rochelle Harper Greenidge

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION FROM RESTRICTION REQUIREMENT UNDER 37 C.F.R. §1.144

Dear Sir:

On October 7, 2003, a Restriction Requirement was made limiting the sole claim in the above-referenced application (“Application”), to one SNP nucleic acid. Applicant elected, with traverse, the sequence of SEQ ID NO: 1 on December 5, 2004.

In Office Action dated February 25, 2004, the restriction requirement limiting the claim to one SNP nucleic acid (made October 7, 2003), was been made final.

Applicant petitions the Director to review this restriction requirement.

On December 5, 2003 (*i.e.*, the same day that Applicant responded to the Restriction Requirement), Applicant filed a petition to convert this Application into a Statutory Invention Registration (SIR). This Application contains the sequences of 325,720 SNP nucleic acids, all of

which Applicant desires to dedicate to the public domain through a Statutory Invention Registration (“SIR”). Applicant’s goal is to allow scientists to freely work on these sequences and possibly identify new diseases and/or correlate the sequences with existing disease states. By converting this Application into an SIR, Applicant will be able to use the SIR defensively as a prior art document to ensure that no one entity can patent a sequence disclosed in this Application, as patenting will remove that sequence from the public domain and prevent the work of scientists on that sequence.

As this Application will never issue as a patent, Applicant respectfully avers that the restriction requirement should not have been maintained, since SIRs are not required to meet the requirements of patentability under 35 U.S.C. §102 or 35 U.S.C. §103. Thus, no search for prior art needs to be done of the sequences of the Application’s sole claim. Moreover, it is not unduly burdensome for the Examiner to examine all of the sequences, since an SIR need only meet the requirements of 35 U.S.C. §112, which Applicant avers that the Application does.

Accordingly, Applicant respectfully requests that the Director reconsider and withdraw the restriction requirement in this Application and allow simultaneous examination of all of the SNP nucleic acid sequences in the Application’s sole claim.

CONCLUSION

Applicant filed this Application containing 325,720 sequences with the intention of dedicating these sequences to the public domain through an SIR. As an SIR does not need to meet the requirements of 35 U.S.C. §102 or 35 U.S.C. §103, Applicant respectfully avers that it is not unduly burdensome for all 325,720 sequences to be examined together. Accordingly, Applicant respectfully requests that the restriction requirement, which limited the Application’s sole claim to one SNP nucleic acid sequence, be reconsidered and withdrawn.

If the Director believes that any further discussion of this communication would be helpful, s/he is encouraged to contact the undersigned by telephone.

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No fees are believed to be due in connection with this communication. However, please apply any additional charges, or credit any overpayment, to our Deposit Account No. 08-0219.

Respectfully submitted,
HALE AND DORR LLP



Nancy (Chiu) Wilker, Ph.D.
Reg. No. 43,545
Agent for Applicants

Date: May 25, 2004

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